

Applicant: Francke et al.
Application No.: 10/559,158

Remarks

Claims 1 to 16, and 21 to 26 are pending in the application; claims 23 to 26 were withdrawn; and claims 1 to 16, 21, and 22 were rejected.

Applicants respectfully request that the rejection be withdrawn and that the claims be reconsidered in view of the amendments and remarks herein. The only rejection of the claims is under 35 U.S.C. §101, and includes a citation to the Court of Appeals for the Federal Circuit's opinion in *In re Bilski*, 88 U.S.P.Q.2d 1385 (Fed. Cir. 2008). Since the date of the action, the Supreme Court of the United States has come down with its opinion and ruling in that case. Thus, the action was not based on the Supreme Court's interpretation of the statute, and reconsideration of the rejections is believed to be necessary.

Rejections Under 35 U.S.C. §101

Claims 1 to 16, 21, and 22 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

Amendments

Initially, it is noted that only method claims remain under consideration in this application, and only claim 1 is an independent claim.

Generally, claim 1 is amended to recite the steps of the method using a milking device and a control device. In particular, the steps, "determining a subgroup milk yield" and "calculating a milk yield..." are amended to recite -- milking the subgroup of animals with milking devices to obtain a milk yield...storing the milk yield...in a control device...and operating the control device to calculate -- a milk yield for the group of dairy animals. This amendment is supported in the specification at paragraphs 19, 20, 26, 42, 43, and 63. For example, paragraph 63 states,

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According to the proposal of the invention the milk yield extracted during a milking session is measured only at some of the milking places. The data collected are sufficiently accurate so as to obtain a statement on the yield capacity of the herd and the individual animals so as to allow a selection for breeding purposes or for modifying the feeding. The equipment required for realizing the invention is relatively small in number, thus improving the cost effectiveness of such an installation.

Thus, the amendment to claim 1 has ample support in the specification and no new matter is added.

Claims 2 and 3 are amended to replace "calculating" with -- operating the control device to calculate --. These amendments are supported in the same way claim 1 is supported and no new matter is added.

Claim 5 simply adds a recitation to a control device being used in the recited method step. Again, the specification paragraphs cited above in relation to amended claim 1 support this amendment, and no new matter is added.

Claims 6 and 16 are amended to correct minor grammatical errors. No new matter is added.

Claim 11 is amended in an effort to improve the grammar and format. Also, the word "machines" is replaced with -- devices -- for consistency with claim 1. No new matter is added.

Claim 14 is amended to recite steps consistently with claim 1. No new matter is added.

Claims 21 and 22 are amended in substantially the same way claims 2 and 3 were amended, as described above. Thus, for the same reasons, no new matter is added.

The Claims Are Allowable

The action implies that the sole test for patentability under 35 U.S.C. §101 is that the claims be (1) "tied to a particular machine or apparatus, *or* (2) it transforms a particular article to a different state or thing." Action, pg. 3, citing to *Gottschalk v. Benson*, 409 U.S. 63 at 70 (1972).

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The action also cites *In re Bilski*, 88 U.S.P.Q.2d 1385, 1391 (Fed. Cir. 2008) to support the “machine-or-transformation” test. (Action, pg. 3, first paragraph.) As stated above, the Supreme Court has interpreted 35 U.S.C. §101 in a manner that is broader than the Federal Circuit’s test for utility.

In particular, the Supreme Court found that the “machine-or-transformation” test is not the only test for whether a patent claim satisfies the utility requirement under 35 U.S.C. §101. The Court stated,

This Court’s precedents establish that the machine-or-transformation test is a useful and important clue, an investigative tool, for determining whether some claimed inventions are processes under §101. The machine-or-transformation test is not the sole test for deciding whether an invention is a patent-eligible “process.”

(*Bilski et al. v. Kappos*, 561 U.S. __ (2010), slip opinion, page 8.) Therefore, the claims for this application were rejected under an overly restrictive standard.

Regardless, the claims now recite milking devices and a control device used to perform the recited method. Thus, even under the outdated standard used in the action, the claims now recite a method that is tied to particular machines or apparatus. Further, the machines or apparatus are not merely an “insignificant post-solution activity” because they are not used “post solution.” Indeed, the milking devices are used to gather data from a subgroup of animals that are used subsequently by the control device to determine a milk yield for a larger group of animals.

The method claims of this application have specialized meanings and qualify for a patent. (See action, pg. 4.) The recitations of claim 1 (and the dependent claims) are also not mere field of use limitations because they actually interact with animals, and gather, manipulate and process milking data from a segregated sub-group of dairy animals to generate milk data for a larger group of dairy animals. The field of use is not merely incidental to the claimed process. Thus, the

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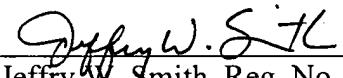
examiner's standard has been met even if it is more restrictive than the approach set forth by the U.S. Supreme Court in *Bilski et al. v. Kappos, id.*

There being no rejections based on prior art or 35 U.S.C. §112, the claims are, therefore, allowable. Applicants respectfully request that the rejections be withdrawn and that this case be passed to issue.

Conclusion

For the foregoing reasons, the claims are allowable, and Applicants respectfully request that this case be passed to issue.

Respectfully submitted,



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